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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,803	07/10/2003	Gregory S. Hamilton	054707-1231	1915
29728	7590	03/08/2004	EXAMINER	
GUILFORD PHARMACEUTICALS C/O FOLEY & LARDNER 3000 K STREET, NW WASHINGTON, DC 20007-5143			AULAKH, CHARANJIT	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/615,803

Applicant(s)

HAMILTON ET AL.

Examiner

Charanjit S. Aulakh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 84-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 84-92 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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### **DETAILED ACTION**

1. According to paper filed on July 10, 2003, the applicants have canceled claims 1-83 and furthermore, have added new claims 84-92.
2. Claims 84-92 are now pending in the application.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 84-92, drawn to compounds of formula II where N-glyoxyl heterocyclic ketone or thioester compound is represented by compounds disclosed in table I on page 21 where n is 1, pharmaceutical compositions containing these compounds and a method of using these compounds, classified in class 548, subclass 530.
  - II. Claims 84-92, drawn to compounds of formula II where N-glyoxyl heterocyclic ketone or thioester compound is represented by compounds disclosed in table I on page 21 where n is 2, pharmaceutical compositions containing these compounds and a method of using these compounds, classified in class 546, subclass 226.
  - III. Claim 84-92, drawn to compounds of formula III where N-glyoxyl heterocyclic ketone or thioester compound is represented by compounds disclosed in table II on page 28 where A and C represent CH<sub>2</sub> and B represents S, pharmaceutical compositions containing these compounds and a method of using these compounds, classified in class 548, subclass 200.

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- IV. Claims 84-92, drawn to compounds of formula III where N-glyoxyl heterocyclic ketone or thioester compound is represented by compounds disclosed in table II on page 28 where A and B represent CH<sub>2</sub> and C represents NH, pharmaceutical compositions containing these compounds and a method of using these compounds, classified in class 548, subclass 334.1.
- V. Claim 84-92, drawn to compounds of formula IV where N-glyoxyl heterocyclic ketone or thioester compound is represented by compounds disclosed in table III on page 30 where A, B and D represent CH<sub>2</sub> and C represents O, pharmaceutical compositions containing these compounds and a method of using these compounds, classified in class 544, subclass 158.
- VI. Claims 84-92, drawn to compounds of formula IV where N-glyoxyl heterocyclic ketone or thioester compound is represented by compounds disclosed in table III on page 30 where A, B and D represent CH<sub>2</sub> and C represents S, pharmaceutical compositions containing these compounds and a method of using these compounds, classified in class 544, subclass 59.
- VII. Claim 84-92, drawn to compounds where N-glyoxyl heterocyclic ketone or thioester compound is represented by compounds other than defined above for groups I through VI, pharmaceutical compositions containing these compounds and a method of using these compounds, classified in classes 540, 544, 546, 548 and 549.

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4. The inventions I through VII as defined above are patentably distinct, each from the other since they are structurally so divergent that a reference showing compounds of invention I would not render compounds of inventions II through VII prima facie obvious. Search required for e.g ; compounds of invention I in class 548, subclass 530 is not the same search required for e.g ; compounds of invention II in class 546, subclass 226 and therefore, constitutes a burdensome search.

5. A telephone call was made to the applicant's attorney, Ms. Suet M. Chong on March 3, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

It is of note that group VII is subject to further restriction based on the ring size, number and types of heteroatoms present in the ring of the heterocyclic ring. If applicants elect group VII, specific structure of the heterocyclic ring must be identified.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

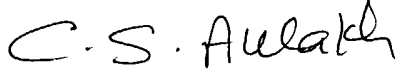
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is

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(571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Charanjit S. Aulakh  
Primary Examiner  
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